



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/778,259	02/07/2001	Cristobal Guillermo dos Remedios	13388	4496

7590 02/01/2007
Scully, Scott, Murphy & Presser
400 Garden City Plaza
Garden City, NY 11530

EXAMINER

CHEU, CHANGHWA J

ART UNIT PAPER NUMBER

1641

MAIL DATE DELIVERY MODE

02/01/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action Before the Filing of an Appeal Brief	Application No. 09/778,259	Applicant(s) REMEDIOS ET AL.	
	Examiner Jacob Cheu	Art Unit 1641	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 27 December 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:
- a) The period for reply expires _____ months from the mailing date of the final rejection.
- b) The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
- (a) They raise new issues that would require further consideration and/or search (see NOTE below);
- (b) They raise the issue of new matter (see NOTE below);
- (c) They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) They present additional claims without canceling a corresponding number of finally rejected claims.
- NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).

5. Applicant's reply has overcome the following rejection(s): _____.

6. Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7. For purposes of appeal, the proposed amendment(s): a) will not be entered, or b) will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
- The status of the claim(s) is (or will be) as follows:
- Claim(s) allowed: _____.
- Claim(s) objected to: _____.
- Claim(s) rejected: 38 and 42-45.
- Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).

9. The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).

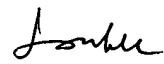
10. The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.

12. Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____

13. Other: _____.


LONG V. LE 01/31/07
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600

Continuation of 11. does NOT place the application in condition for allowance because: Applicant submitted obviousness-related cases have been reviewed and considered. In light of the holdings of the case law, and the prior arts discussed from the Final Office Action, examiner would still maintain the rejections.

First, applicant argues that the "ordinary skill in the art" should be a scientist "in the environmental science who can detect heavy metal toxicants in the environmental samples", and "it is unlikely to identify the article by Liu et al., which is directed to a different field of endeavor.... "it is not reasonably pertinent to the particular problem." (See Remarks, page 6, second paragraph).

Applicant's argument has been considered but is not persuasive.

As a scientist, it is not a taboo to search strictly to a limited field. The driving force is always based upon the need of problem solving. The impact and concern of heavy metal, for example, copper (Cu), in the environment is well-known and well-established. One ordinary skill in the art would endeavor to solve this problem using every available means. Usually the first step is to search the key word- "copper" (Cu) in all related area, including environmental science, biology, ecology, biochemistry, organic chemistry and inorganic chemistry. The Liu et al. paper is the pertinent because it deals with the essence of the problem, i.e. copper. Additionally, examiner has experience in cancer research, yet examiner owned degree of "environmental science". It is not uncommon to endeavor in different research areas to one ordinary skill in the art.

Second, applicant argues that the prior arts are not in analogous field and therefore are not sound "logic and scientific reasoning".

Applicant's argument has been considered but is not persuasive.

As discussed, the motivation is for solving the problem. This has been provided and established. Furthermore, the Liu et al. paper, albeit in chemistry field, can not preclude one's endeavor to search in this field if necessity arises. Moreover, environmental science is a multi-disciplined field crossover numerous areas, including biology, chemistry, physics, ecology, policy-making..etc. It is not illogical and unreasonable to search in the related area with a fixed goal.